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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,021	12/02/2003	Timothy W. Lovenberg	JJPR-0043	5495

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EXAMINER

HAMUD, FOZIA M

ART UNIT PAPER NUMBER

1647

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/727,021	LOVENBERG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Fozia M. Hamud	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24,25,27,28,34,35,38,40 and 53-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24,25,27,28,34,35,55-57 and 60-62 is/are allowed.
- 6) ☒ Claim(s) 40, 53-54, 58-59, 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Response to Amendment**

1a. Receipt of Applicants' amendment and arguments filed on 13 March 2006 is acknowledged.

**Status of Claims:**

1b. Claims 1-23, 26, 29-33, 37, 39 have been cancelled and new claims 41-54 have been added. Thus, claims 24, 25, 27-28, 34-36, 38 and 40-54 are pending, and under consideration.

1c. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

2. The following previous objections and rejections are withdrawn in light of Applicants amendment filed 03/13/06.

(I) The rejection of claims 24, 27, 34-35, 38, 40 and 53-54 made under 35 U.S.C. 12, first paragraph, for enabling the full scope of the claimed invention is withdrawn.

The claims now recite the specific ligands and the specific biological activity.

(II). The rejection of claims 24-25, 27-28, 34-36, 38 and 40-54 are rejected under 35 U.S.C. § 112, second paragraph, reciting the articles "a or an", when referring to specific sequences.

**New Rejections:**

**Claim Rejections - 35 U.S.C. § 112, second paragraph:**

3. Claims 40 and 53-54, 58-59, 63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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3a. Claim 40 is drawn to a kit for detecting the presence of a nucleic acid molecule encoding a human histamine H3 receptor, however, the claim fails to recite the composition of said kit. In lines 2-3, the claims recites "...., wherein said nucleic acid molecule comprises the nucleic acid of SEQ ID NO:5, 6, or 8....", therefore, it is unclear whether SEQ ID NO:5, 6 or 8, are the sequences being detected by the claimed kit, or whether the kit comprises SEQ ID NO:5, 6 or 8. Furthermore, the claim recites ".....and optionally a container...", in line 7, however, it is unclear whether said container is part of the claimed invention. See MPEP § 2173.05(d). Claim 40 also lacks means of detecting the presence of the nucleic acid of interest. In the event Applicants amend claim 40 to encompass a kit that comprises the nucleic acid of SEQ ID NO:5, 6 or 8, this may precipitate double patenting rejection between claim 40 and claim 1 of U.S. Patent 6,413,743, which is drawn to an isolated nucleic acid which encodes the polypeptide of SEQ ID NO:7.

Claims 53-54, 58-59 and 63 are rejected in so far as they depend from claim 40.

3b. Claims 58 and 59 recite "the method of claim 40 or 54", respectively, however, claims 40 and 54 are drawn to a kit and not to method. Appropriate correction are required.

**Conclusion:**

5. Claims 24-25, 27-28, 34-35, 38, 55-57, 60-62

It is recommended that claims 24, 27, 38, 40, be amended to delete "comprises", and insert "is selected from" before "binding to a histamine H3 receptor".

**Advisory Information:**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M. Hamud whose telephone number is (571) 272-0884. The examiner can normally be reached on Monday, Thursday-Friday, 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Art Unit 1647

09 June 2006

  
BRENDA BRUMBACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600